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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,434	06/09/2000	Dean F. Jerding	A-6594	1996

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2623	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/590,434	JERDING ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *134-138* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *134-138* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Miscellaneous

1. Please note that the examination art unit for this application has changed to Art Unit 2623.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 134-138 of this application. In particular, the examiner cannot find support for the claim language of the independent claims such that the user is provided with options as to whether or not to display preceding movie trailers and promotional advertising wherein irrespective of the particular selection and responsive to a third input providing the user with suspension promotional advertising. The provisional application makes references to a similar architecture as that utilized by the instant application, however, there does not appear to be an enabling disclosure pertaining to the particular usage of such in conjunction with the claimed combination of elements.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed subject matter of claims 134 must be shown or the feature(s) canceled from the claim(s). In particular, the illustrations fail to illustrate the limitations such that "responsive to a presentation specific

rental flag . . . enabling a plurality o fuser-selectable rental options specific to each one of the plurality of on-demand rentable video presentations" wherein these options correspond to displaying the "on-demand rentable video presentation without presentation promotional advertising" and "without preceding movie trailers". While Step 213 references the particular display of title purchase options, there is no illustration of that screen providing the particular options claimed. Furthermore, the particular step of "suspending the provision of the rentable video presentation and providing the user with suspension promotional advertising responsive to the third user input" which is independent of the particular presentation and independent of the first and second rental options is not shown. The particular display of a suspension related content appears to be illustrated in Figure 21; however, there is no nexus between this step and the process flow illustrated in Figure 5. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either

"Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Response to Arguments

4. Applicant's arguments with respect to claims 134-138 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's arguments regarding the particular usage of "presentation specific rent flags received from the server", the instant application discloses the usage of rentFlags which indicate support for 'other rental options' (Page 18, Line 19). As set forth in the Microsoft Press Computer User's dictionary (1998), a "flag" is defined as a marker of some type used by a computer in processing or interpreting information. Furthermore, both the Skarbo et al. and Logan et al. references teach that those skilled in the art would recognize that HTML utilizes tags or "flags" so as to define the particular layout presentations (Skarbo et al.: Col 4, Lines 16-26) (Logan et al.: Col 36, Lines 45-65). Accordingly, the particularly disclosed usage by White et al. of a user interface which is displayed based upon HTML is considered to meet the claimed limitation of a "rent flag" which enables the particular display of billing options associated with renting a particular presentation.

With respect to applicant's traversal regarding a number of statements in the grounds of rejection having not been evidenced, the examiner respectfully disagrees. It is noted,

however, that the particular claims directed towards these statements have been cancelled which would appear to render applicant's statements moot. In any event, applicant's traversal would appear to imply that evidence had not been already been provided and that the facts are too detailed and were presented in the of claimed combinations that are too complex to be considered well-known. Given that the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. Chore-Time Equipment, Inc. v. Cumberland Corp., 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also Okajima v. Bourdeau, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001). In the instant case, the examiner did not rely upon common knowledge or OFFICIAL NOTICE so as to support the particular statements, but rather the statements were evidenced by the references utilized in the prior grounds of rejection. For example, regarding the statement that it is known and desirable to "provide a user option to select whether the on-demand presentation is presented with promotional advertising" such that the user is operable to adjust the billing based upon the level of advertising desired evidence was previously provided in the form of the Blahut et al. reference (Col 6, Lines 4-43). Regarding the particular statements as to the "existence of promotions or "movie trailers" as being notorious well-known in the art, the rejection relied upon the "Movie Trailer Trash article" which provided existence of movie trailers as being known for at least the past 90 years in movie theaters and at least 20 years on television. As set forth in the rejection, the LaJoie et al. reference discloses that it is known in the art to distribute video over a "second communication channel" using QAM and to

further distribute TCP/IP data via a "first communication channel" using QSPK modulation (Col 12, Lines 11-19; Col 12, Line 60 – Col 13, Line 5; Col 13, Line 66 – Col 14, Line 45). Finally, the Goldman et al. reference provides evidence that it is known and advantageous to provide "updated portions of promotional advertising corresponding to a merchandise advertisement tailored for the user of the STT" (Goldman et al.: Para. [0007], [0012] – [0015], [0038], and [0040]). Accordingly, the applicant's conclusionary traversal regarding particular statements provided in the previous action is not persuasive.

Claim Objections

5. Claim 134 is objected to because of the recitations of "the presentation" and "the particular presentation" lacks proper antecedence. The examiner shall presume that "the particular presentation" is the same as the "selected one of the plurality of on-demand rentable video presentations" corresponding to the first user input. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 134 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Neel et al. (US Pat No. 5,838,314), in view of the Bee article, and in further view of Matthews, III et al. (US Pat No. 5,914,746).

In consideration of claim 134, the Figure 1 of the White et al. reference illustrates a "television set-top terminal ("STT")" [14] "coupled to a server" [12] via a "bi-directional communication network" [16]. The "set-top terminal" [14] comprises a "memory having program code stored therein" [40/42] (Col 3, Lines 1-8) and at least "one processor that is programmed by the program code to enable the STT" [38] (Col 2, Lines 63-67). The system is operable to "receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations" (Col 3, Lines 28-40) and "provide a media guide presentation to a user via a television signal" (Figure 4) wherein the "media guide presentation comprises at least a portion of said media guide data corresponding to a plurality of on-demand rentable video presentations (Col 4, Lines 12-38).

The system "receives a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation" (Col 4, Lines 12-38) and in response provides a billing option screen which is considered to be "responsive to presentation specific rent flags received from the server" associated with the HTML-based

primitives utilized to instruct the "STT" [14] to derive/render the user interface. The reference, however, is silent with respect to the particular provisioning of rental options. In an analogous art pertaining to television systems and the field of media-on-demand, the Neel et al. reference discloses a media-on-demand system that "enables a plurality of user selectable rental options specific to each one of the plurality of on-demand rentable video presentations" (Col 13, Lines 34-45; Col 18, Lines 10-42) such that particular advertisements and particular options are provided in accordance with the advertisers instructions. The specification does not clearly support or disclose that the claimed "options" are necessarily separately/independently selectable (IA: Page 21, Lines 28-32). The "STT" [120] subsequently "configures a first rental option in the plurality of selectable rental options to provide a viewer selectable option to view a user-selected on demand rentable video presentation without presentation promotional advertising that is otherwise shown during the presentation of the user-selected on-demand rentable video presentation" and "configure a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable movie presentation without preceding [advertisements] that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation" (Figure 7A; Col 14, Line 49 – Col 15, Line 66). In particular, the user is provided with options to watch none or one or more advertisements before, during, or after the transmission of the video program which are otherwise displayed if the user desires to watch the movie for a reduced price. The "STT" [120] subsequently "receives a second user input responsive to providing the first rental option and the second rental option" [606] (Col 17, Lines 45-66) wherein the "STT" [120]

"provides the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding [advertising] responsive to the second user input corresponding to the selection of the first rental option an the second rental option" [638] in accordance with presenting the movie in response to the users preferences (Figure 4). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the White et al. billing option screen such that the "STT" [14] "responsive to presentation specific rental flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation; configure a first rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation of the user-selected on-demand rentable video presentation; configure a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding [advertisements] that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation; . . . . receive a second user input responsive to providing the first rental option and the second rental option; and provide the one of the plurality of rentable video presentations to the user without presentation promotion advertising during the presentation and without preceding [advertising] responsive to the second user input corresponding to the selection of the first rental option and the second rental option" for the purpose of offering and providing video-on-demand services wherein

the users can advantageously choose on a transaction by transaction basis to have advertisers or other third parties pay for these services (Neel et al.: Col 2, Lines 49-61).

With respect to the particular usage of a species of advertising or "movie trailers", the Neel et al. reference is silent with respect to the preceding advertisements being "movie trailers" nor does it preclude the particular type of advertisement being presented. In an analogous art pertaining to television systems, the Bee article provides evidence as to the existence of "movie trailers" in the television environment as well as the fact that movie trailers are advertisements which precede the feature presentation. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly utilize "preceding movie trailers" as the disclosed proceeding advertisements of Neel et al. for the purpose of developing recognition and creating a desire to see the particularly advertised movie as taught by the Bee article.

The combined references and in particular the White et al. reference discloses the ability to "suspend the provision of the rentable video presentation" (Col 5, Lines 46-58). The White et al. reference further incorporates by reference the particular features of an electronic program guide such as that disclosed by Lawler et al. (US Pat No. 5,58,838) (hereafter '838) (Col 5, Line 58 – Col 6, Line 15). The Lawler et al. ('838) reference discloses an independent program guide application which provides "promotional advertising . . . configured by the server" [26] in the form of video previews for upcoming programming (Col 6, Lines 11-17; Col 10, Lines 28-56). The reference, however, is not clear with respect to the "particular display of promotional advertising responsive to third user input" associated with changing channels. In particular, the reference is unclear with respect to how

the electronic program guide with its associated promotional advertising is necessarily activated. In an analogous art pertaining to the field of television systems and in particular media-on-demand, the Matthews, III et al. reference teaches a method whereby independent electronic program guide and video-on-demand applications are allocated to separate channels (Figure 3; Col 3, Lines 11-67). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify White et al. so as to associate an independent electronic program guide application with a separate channel for the purpose of providing a means to advantageously select between various services simply by tuning to the associated service channel (Matthews, III et al.: Col 2, Lines 3-43). Therefore, taken in combination, the references disclose "suspending the provision of the rentable video presentation responsive to a third user input" corresponding to changing channels to the independent electronic program guide application, "wherein the suspension promotion advertising" associated with various video previews for future programming "provided during suspension of the presentation is configured by the server and is independent of the particular presentation" previously viewed by virtue of the fact that EPG is a separate application and the user can view previews for other programming. It is also "independent of the first rental option and the second rental option" because the particular displayed trailers are independent of or are for different presentations than the suspended presentation and the particular application through which they are presented is a separate and distinctive application.

In consideration of claim 135, the White et al. reference also explicitly incorporates the Lawler et al. (US Pat No. 5,907,323) (hereafter '323) reference with respect to aspects of

electronic program guides (Col 5, Lines 58-66). The Lawler ('323) reference discloses that it is desirable for program guides to provide more detailed information regarding upcoming programming which includes video previews or "movie trailers provided through a movie trailer channel to which the STT tunes" in association with the presentation of the programming guide (Figure 5; Col 2, Lines 28-37; Col 9, Lines 33-48). The Lawler et al. ('323) is silent with respect to further providing an option to order a program for which there is a movie trailer. The Lawler et al. ('838) reference, previously noted as also being incorporated by reference into White et al., teaches that in association with an electronic program guide that it desirable to provide with enhanced program guide interactivity and that a user viewing a preview is "provided an option to purchase for future rental at least one movie corresponding" to the preview (Figure 8; Col 6, Lines 7-21; Col 10, Lines 42-56; Col 14, Lines 30-48). Accordingly, it would have been obvious one having ordinary skill in the art at the time the invention was made so as to modify the electronic program guide of Lawler et al. ('838) so as to employ the teachings corresponding to "movie trailers provided through a movie trailer channel" of Lawler ('323) for the purpose of providing enhanced program information to viewers (Lawler ('323): Col 2, Lines 28-37) and to subsequently utilize the teachings of the combined references as an electronic program guide as expressly taught/incorporated by White et al. Therefore, taken in combination, the "suspension promotional advertising provided during suspension of the presentation corresponds to movie trailers provided through a movie trailer channel to which the STT tunes during the suspension of the presentation" in responsive to the user suspending the presentation in association with changing the channel to view the electronic program guide and displaying

preview information for available orderable presentations "wherein the user is provided an option to purchase for future rental at least one movie corresponding to the movie trailers during the suspension of the presentation" in association with the displayed order button in the electronic program guide application.

9. Claims 136-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Neel et al. (US Pat No. 5,838,314), in view of the Bee article, in view of Matthews, III et al. (US Pat No. 5,914,746), and in further view of Kikinis (US Pat No. 5,929,849)

In consideration of claims 136-138, as aforementioned, the Neel et al. reference discloses the particular usage of interactive commercials. The reference, however, is silent with respect to what is necessarily displayed in those commercials such that the "presentation promotional advertising corresponds to logos" or "brands", or "marks provided to the user with the one of the plurality of rentable video presentations". In an analogous art pertaining to television systems, the Kikinis discloses interactive commercials or advertisements which comprises "logos", "brands", or "marks" (Figure 2A) coinciding with an automobile. Accordingly, it would have been obvious to one having ordinary skill in the art so as to modify the "presentation promotional advertising" of Neel et al. so as to utilize advertising such as that provided by Kikinis for the purpose of providing a means by which to easily and quickly access information detail about products advertised (Kikinis: Col 2, Lines 52-59).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2623

SEB
May 9, 2006